

REMARKS

Claims 1, 4-6, 9 and 10 are pending in this application. By this Amendment, claims 1 and 6 are amended. The amendments introduce no new matter. Claims 2, 3, 7 and 8 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed below; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution and the claim amendments simply incorporate subject matter from dependent claims as features of independent claim 1; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for Appeal, should an Appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the Final Rejection. Entry of the amendments is thus respectfully requested.

The Office Action, in paragraph 1, objects to claims 6-10 as being in improper dependent form. Specifically, the Office Action indicates that the claims are directed to projecting an image with the fixed-focus projection lens of other claims. The Office Action states "[h]owever, it is conceivable to one ordinarily skilled in the art that any other projection lens can project the image." Therefore, the Office Action alleges that these claims do not further limit other claims from which they depend. This is an improper and unsupportable conclusion. Claims 6, 9 and 10 are to an apparatus, specifically, an optical projector, comprising: an image forming means for forming an image; and the fixed-focus projection lens according to claim 1 (or 4 or 5) for projecting the image formed by the image forming means. It is an improper conclusion that it is conceivable to one of ordinary skill in the art

that any other projection lens can project the image when clearly these claims circumscribe the subject matter as including a specific fixed-focus projection lens, the detailed features of which are recited in other claims. Claims 6, 9 and 10 are drawn to an optical projector including the fixed-focus lens of claims 1, 4 and 5, respectively. No "other" projection lens meets the language recited in the claims. Withdrawal of the objection to claims 6, 9 and 10 are respectfully requested.

The Office Action, in paragraph 2, rejects claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 1 is amended to obviate the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §112, second paragraph, are respectfully requested.

The Office Action, in paragraph 4, rejects claims 1 and 6 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,946,144 to Yamamoto. This rejection is respectfully traversed.

Yamamoto teaches a zoom lens in which the first lens group, G1, and the second lens group, G2, are movable with respect to the third lens group, G3 (col. 2, lines 56-61). This is shown in TABLES as "Variable". Further, Yamamoto teaches a lens group that includes ten lenses as shown in Fig. 1 or eight lenses as shown in Fig. 2. For just these disclosures, Yamamoto cannot reasonably be considered to teach, or to have suggested, a fixed-focus projection lens consisting of six lenses.

In response to Applicant previously asserting this argument, the Office Action indicates that the recitation of a fixed-focus projection lens need not be given patentable weight because the recitation occurs in the preamble. The Office Action indicates that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process or structural limitations are

able to stand alone. While this may be an appropriate recitation of precedent, it is not germane to rebutting Applicant's arguments. The preamble to claim 1 does not "merely recite the purpose of a process or the intended use of a structure." Rather, the preamble indicates that the subject matter of the pending claims is drawn to a "fixed-focus projection lens." In making a rejection under 35 U.S.C. §102, a claim cannot be read in such a manner as to vitiate any positively recited term. In finding the fixed-focus projection lens of the pending claims to be anticipated by the variable focus lens of Yamamoto, the Examiner must improperly read the claims in such a manner as to vitiate at least the term "fixed-focus."

Further, the positively recited term consisting of six lenses cannot be anticipated by a structure that does not "consist of six lenses."

In reviewing the anticipation standard, the Federal Circuit stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added). Additionally, other court precedent clarifies the requirements for anticipation based on arguably distinct teachings in a single prior art reference, stating that "the reference ... must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524 (CCPA 1972); *see also Sandisk Corp. v. Lexar Media, Inc.*, 91 F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that "[u]nless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation.") and *Aero Industries Inc. v. John Donovan Enterprises-Florida Inc.*, 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that "[n]ot only must a prior patent or

publication contain all of the claimed elements of the patent claim being challenged, but they 'must be arranged as in the patented device' ").

This standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the . . . claim." Further, although the same terminology need not be used, "the elements must be arranged as required by the claim."

The above-quoted standard for anticipation is not met by the Office Action. The combination of all of the features positively recited in independent claim 1 cannot reasonably be considered to be taught by the Yamamoto reference. Additionally, claim 6 is neither taught, nor would it have been suggested, by Yamamoto for at least the dependence of this claim on independent claim 1, as well as for the separately patentable subject matter that this claim recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 6 under 35 U.S.C. §102(b) as being anticipated by Yamamoto are respectfully requested.

The Office Action, on page 4, rejects claims 2, 3, 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Yamamoto. The cancellation of these claims renders this rejection moot. To the extent, however, that the subject matter of claims 2 and 3 is incorporated into claim 1 the following conclusion applies. Because Yamamoto does not anticipate the subject matter recited in claim 1 for the reasons indicated above, claim 1, as amended, also cannot reasonably be considered to have been suggested by this reference.

The Office Action, in paragraph 3, rejects claims 4 and 9 under 35 U.S.C. §103(a) as being unpatentable over Yamamoto in view of U.S. Patent Application Publication No. US 2002/0176058 to Yasui et al. (hereinafter "Yasui"); and in paragraph 4, rejects claims 5 and 10 under 35 U.S.C. §103(a) as being unpatentable over Yamamoto in view of U.S. Patent

Application Publication No. US 2004/0051964 to Endo et al. (hereinafter "Endo"). These rejections are respectfully traversed.

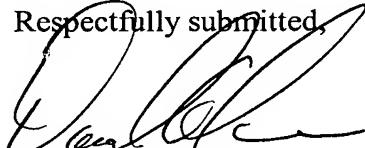
Neither Yasui nor Endo is asserted to teach, or to have suggested, the above described features of independent claim 1. As such, neither Yasui nor Endo can overcome any shortfall in the application of Yamamoto to the subject matter of independent claim 1.

For at least this reason, claims 4, 5, 9 and 10 are neither taught, nor would they have been suggested, by any combination of Yamamoto with Yasui and/or Endo for at least the respective dependence of these claims directly or indirectly on independent claim 1, as well as for the separately patentable subject matter that each of these claims recites. It should be noted in this regard that each of claims 9 and 10, for example, do, in fact, positively recite the fixed-focus projection lens according to, respectively, claims 4 and 5.

Accordingly, reconsideration and withdrawal of the rejections of claims 4, 5, 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Yamamoto in combination with either Yasui or Endo are respectfully requested.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 4-6, 9 and 10 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,

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